

REMARKS

1. Claims 20 and 21 are pending in the application and have been amended to more particularly point out and distinctly claim the subject matter applicants regard as the invention. In particular, in claim 20, the "P" defined as being "1 to 4" has been replaced with a lower case "p," which is consistent with the claim 20 structural formula and does not introduce new matter. Claim 20 has also been amended to clarify that the G' "substituted aralkyl" is an "aralkyl having one or more substitutions on the aryl." This is disclosed in the original specification at page 7, lines 23 – 24, and also does not introduce new matter. Claim 21 has been amended to delete the second definition of "P" and to define R^1 and R^2 , which was inadvertently omitted from the prior amendment when rewriting claim 21 in independent form and incorporating the limitations of claim 20. Thus, no new matter has been introduced to claim 21.

Accordingly, the claim amendments do not introduce new matter. Nor do they raise any new issues that would call for a new search or require burdensome work on the part of the Examiner. Instead, the amendments address matters of form, for which entry is permitted under 37 C.F.R. §1.116. Furthermore, the number of claims do not exceed the number under Final Rejection. Therefore, it is respectfully requested that the claim amendments be entered for purposes of appeal in the event, for some reason, the claims are not deemed to be in condition for allowance.

However, in view of the above claim amendments, the claims are believed to be in condition for allowance. The claim amendments are believed to resolve the concerns raised by the Examiner, and reconsideration is respectfully requested. In the event any issues remain outstanding, the Examiner is asked to call the undersigned at the telephone number indicated below.

2. Turning to the Official Action, claim 21 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter Applicants regard as the invention. The Examiner noted that,

“there is a conflict between the two definitions [of P], and second, there is no variable ‘P’ (in the structural formula) in which ‘P’ is [upper case].” This rejection is respectfully traversed in view of the above claim amendments for the following reasons.

Claim 20 has been amended to make the upper case “P” a lower case “p,” thereby overcoming this rejection by the Examiner under 35 U.S.C. §112, second paragraph. In addition, claim 21 has been amended to eliminate the definition of “P is 1 to 4” in the second-to-last line.

Therefore, in view of the above remarks and amendments, this rejection of claim 21 has been overcome. Reconsideration by the Examiner and withdrawal of this rejection is therefore respectfully requested.

3. Next, claim 20 was rejected under 35 USC §102(b) in view of the Klinger et al. patent. The Examiner cited a compound from Example 9 in Klinger and stated that it would anticipate the present invention when X and F’ are hydrogen, B is methyl and G’ is a “substituted aralkyl.” The Examiner maintained his interpretation of the term “substituted aralkyl” as including 2,2-diphenylethyl groups, i.e., an alkyl-substituted phenyl in which the alkyl is further substituted with another phenyl, despite this being contrary to the definition in the specification for the term “substituted aralkyl.” This rejection is respectfully traversed in view of the above claim amendment for the following reasons.

For a rejection of claims under 35 U.S.C. §102 to be proper, each and every element of the claimed invention must be described in the exact same way and function in the exact same way as disclosed in the cited reference. There are significant differences between the present invention and the cited compound in Klinger, et al.

The Official Action raised the issue of possible, conflicting definitions of “substituted aralkyl.” This term has been amended to read “aralkyl having one or more substitutions on the aryl”. This definition eliminates any potential confusion and excludes the “2,2-diphenylethyl” group from Example 9 of the Klinger patent.

The fact that the cited Klinger et al. compound is disclosed by Klinger et al. to be an intermediate is not offered to traverse the rejection for anticipation, but rather to demonstrate that the differences between the claimed compounds and the cited Klinger et al. compound are non-obvious. In other words, claim 20, as amended, now patentably defines over Klinger et al. under both 35 U.S.C. §102(b) and §103(a).

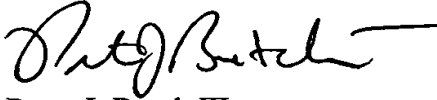
Therefore, in view of the above remarks and amendments, this rejection of claim 20 under 35 U.S.C. §102(b) has been overcome. Reconsideration by the Examiner and withdrawal of this rejection is therefore respectfully requested.

4. Therefore, in view of the above remarks and amendments, it is believed that claims 20 and 21 are in condition for allowance. Reconsideration is respectfully requested. The Examiner is reminded to telephone the undersigned if there are any remaining issues in this application to be resolved.

Finally, if there are any additional charges in connection with this response, the Examiner is authorized to charge applicants' Deposit Account No. 19-5425.

Respectfully submitted,

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